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EXAMINER

COBY, FRANTZ

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 01/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/749,257

Applicant(s)

HSIAO ET AL.

Examiner

Frantz Coby

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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This is in response to Applicant's amendment filed on August 12, 2003 in which claims 1, 6, 11, 15, 20, 26-27 and 29-33 and claim 10 was canceled.

Status of Claims

Claims 1-9 and 11-33 are pending.

The Independent claims were amended incorporating limitations of canceled claim 10 and portion of amended claim 6 that were already addressed in the rejection of (paper # 6 mailed on February 12, 2003).

Applicant's arguments filed on the aforementioned date have been fully considered but they are not persuasive. Therefore the rejection of claim 1-9 and 11-33 of (paper # 6 mailed on February 12, 2003) remains.

The Rejection Follows:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vellandi U.S. Patent no. 6,385,614.

As per claim 1, Vellandi discloses the invention including "a method for controlling online access to reference materials" by providing a shared electronic book which multiple users each have the right to access the book but only one of the users is allowed to actually access the book at a given point in time (See Vellandi Abstract). In particular, Vellandi discloses the claimed limitations "receiving an online request for a reference material" as a subscriber using the subscriber computer 14 to communicate a request (See Vellandi Col. 6, lines 18-36). Also, Vellandi discloses the claimed feature "providing access to the copy of the requested material if the requested reference material is available" as a book -not presently allocated to another subscriber where the server 12 conveys a message to the subscriber computer 14 via the Internet system 16

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that the subscriber has been granted exclusive access to the book (See Vellandi Col. 6, lines 33-43). Further, Vellandi discloses the claimed feature of "determining if a server has possession of a token corresponding to the requested reference materials" as a cookie that is transmitted to the user from the server when a username and password is valid (col. 6, lines 27-33). Last, Vellandi discloses the claimed feature of "passing a token if a copy of the requested material is available" as a subscriber that uses the subscriber's computer 14 to communicate a request which includes a cookie to the server for access to a particular shared book (See Vellandi Col. 6, lines 33-36).

It is noted that although Vellandi specifically detailed the aspect of providing access to a book only if the book is available (not presently allocated to another subscriber) and denying access to a subscriber when the server does not receive a request with the noted cookie from the subscriber within a predetermined period of time, Vellandi did not specifically recite the claimed limitation of "temporarily denying access to the requested reference material if the requested reference material is not available" as recited in the instant claim 1. However, one of ordinary skill in the art at the time of the invention would have found it obvious that the aspect of "temporarily denying access to the requested reference material if the requested reference material is not available" would have occurred in the system of Vellandi whenever a book is presently allocated to another subscriber. The motivation being, to permit the owner of the electronic book to control access of the book more efficiently.

As per claim 2, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature "transmitting the copy of the requested reference material as a digital electronic file" by providing individuals access to an electronic book (col. 1, lines 46-47) where a copy of the electronic book is transmitted to the subscriber's computer 14 when the electronic book is available.

As per claims 3-4, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses "a client side management programmed to provide an indication when the transmitted copy of the requested reference material has been replaced" through a browser program on the subscriber computers (Figure 1, component 14). Although Vellandi discloses transmission of a book from the server to a user; It is noted that Vellandi did not specifically describe the aspect of "transmitting the copy of the requested material as HTML". However, Vellandi discloses mechanism to communicate electronic book through the World Wide Web. One of ordinary skill in the art at the time of the invention would have found it obvious to have the electronic book of Vellandi being communicate as HTML since the layout language for the World Wide Web or Web documents is Hypertext Markup Language and web documents are stored in HTML format in association with server software or remote software.

As per claim 5, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In

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addition, Vellandi discloses the claimed feature "receiving an indication when access to the copy of the requested material is terminated" by permitting termination of a subscriber's access to a book upon expiration of the predetermined period (See Vellandi Col. 6, line 59-co1.7, line 2).

As per claim 6, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "receiving an indication in the form of a return of the token when access to the copy of the requested material is terminated" by providing mechanism for allowing a cookie to be returned before the predetermined period of time to access the book is about to be terminated so that the subscriber can then renew his/her access to the book (See Vellandi Col. 2, lines 29-63; col. 1, lines 51-60).

As per claims 7-8, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses "monitoring a client side browser to determine the client side browser has been for a prescribed period of time and to determine when an image of the requested reference materials has been replaced" by providing users access to the share electronic book for a predetermined period of time in which the client's browser is monitored (See Vellandi Col. 2, line 29-col. 3, line 18).

As per claim 9, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "Comparing a number of copies of the requested reference materials to which access is currently being provided with a maximum number of copies of the requested reference materials for which access can contractually be provided" by providing a counter which when equal to 1 determines whether a book is available to be transmitted to a subscriber through a process that compares a number of copies of the requested book to which access is currently being provided with a maximum number of copies of books (See Fig. 6; Col. 9, lines 10-29).

As per claim 11, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed features of --providing view access or denying view access to the requested reference material-- by providing mechanism for allowing a subscriber to view a selected book (See Vellandi Fig. 213; Col. 6, lines 11--17; col. 5, lines 45-48).

As per claim 12, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "receiving an indication from a client side agent in the form of a return of a token when the copy of the requested material has been replaced in a client side browser" by providing mechanism for allowing a

cookie to be returned before the predetermined period of time to access the book is about to be terminated so that the subscriber can then renew his/her access to the book or for the cookie to be transmitted to another user who wants to access the electronic book (See Vellandi Col. 2, lines 29-63; col. 1, lines 51-60). Notice that the subscriber computers 14 each include a web browser (See Vellandi Col. 5, lines 44-47).

As per claim 13, most of the limitations of this claim have been noted in the rejection of claim 11. Applicant's attention is directed to the rejection of claim 11 above. In addition, Vellandi discloses "transmitting a client side agent from a server" as transmitting a cookie to the requested subscriber and "receiving an indication from the client side agent when the copy of the requested reference material has been replaced in a client side browser" (See Vellandi Col. 6, lines 18-58).

As per claim 14, most of the limitations of this claim have been noted in the rejection of claim 11. Applicant's attention is directed to the rejection of claim 11 above. In addition, Vellandi discloses a requested reference material that is a text segment since the reference materials in this are electronic books (See Vellandi Abstract).

As per claim 15, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. Regarding the claimed feature of "determining if the requested reference material is made available on limited basis or on an unlimited basis" Vellandi achieved these

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limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 16, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant's attention is directed to the rejection of claim 15 above. In addition, Vellandi discloses the claimed feature of "determining whether a server has possession of a token corresponding to the requested reference materials" as a cookie that is transmitted to the user from the server when a username and password is valid (col. 6, lines 27-33). Notice that in Vellandi the server always maintains possession of the cookie and release it when a request is made by a subscriber.

As per claim 17, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant's attention is directed to the rejection of claim 15 above. In addition, as to the claimed feature of transmitting "a computer readable copy of the requested material to a requester's computer" Vellandi achieved that since Vellandi's method is being implemented in a network of computers (See Vellandi Figure 1).

As per claim 18, most of the limitations of this claim have been noted in the rejection of claim 15. Applicant's attention is directed to the rejection of claim 15 above.

In addition, Vellandi discloses the claimed feature of "receiving an indication when the requester has finished accessing the requested material" as a cookie which is returned to the server as an indication that the requester has finished accessing the requested material (See Vellandi Col. 1, line 64-Col. 2, line 5).

As per claim 19, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses the claimed feature of "passing possession of a token corresponding to the requested reference material from a server to the requester each time that on-line access to the requested material for the requester is provided if the requested material is made available on a limited basis; receiving an indication in the form of a return of the token corresponding to the requested reference material each time the requester has finished accessing the requested material (See Vellandi Col. 1, line 51-Col. 2, line 28).

As per claim 20-24, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. Regarding the claimed feature of --providing limited access and unlimited access collection of reference material-- Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right

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to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10). As to the claimed feature of "allowing only a central authority, to update the limited access collection of reference material" this can be achieved by the system administrator through the Internet Server Provider (See Vellandi Col. 5, lines 57-60).

It is noted however, Vellandi did allow users to update unlimited access collection of reference materials as recited in the instant claim 20. However, the Examiner takes official notice that allowing users to update a reference is well known in the art.

As per claim 25, most of the limitations of these claims have been noted in the rejection of claim 20. Applicant's attention is directed to the rejection of claim 20 above. In addition, Vellandi discloses a user interface as L'O interface 18 and I/O interface 20 (See Vellandi figure 1).

As per claim 26, most of the limitations of this claim have been noted in the rejection of claim 20. Applicant's attention is directed to the rejection of claim 20 above. Regarding the claimed feature of "determining if the requested reference material is made available on limited basis or on an unlimited basis" Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since

subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 27, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Vellandi discloses an interface as I/O interface 18 and I/O interface 20 (See Vellandi figure 1). A "processor programmed" primarily incorporated in the computer network of figure 1. Regarding the claimed feature of --determining if the requested reference material is made available on limited basis or on an unlimited basis-- Vellandi achieved these limitations by providing mechanism to allow a subscriber access to books that he:/she does not share with another subscriber, in this case access is unlimited, and mechanism for allowing subscribers to share books, in this case access is limited since subscribers has the right to access but cannot access at the same time as another subscriber is accessing the book (See Vellandi Figure 2A; Col. 6, lines 1-10).

As per claim 28, most of the limitations of this claim have been noted in the rejection of claim 27. Applicant's attention is directed to the rejection of claim 27 above. In addition, Vellandi discloses a requested reference material that is a text segment since the reference materials in this are electronic books (See Vellandi Abstract).

As per claim 29, all the limitations of this claim have been noted in the rejection of claim 27. It is therefore rejected as set forth above.

As per claim 30, all the limitations of this claim; have been noted in the rejection of claim 1. It is therefore rejected as set forth above.

As per claim 31, all the limitations of this claim have been noted in the rejection of claim 11. It is therefore rejected as set forth above.

As per claim 32, all the limitations of this claim have been noted in the rejection of claim 15. It is therefore rejected as set forth above.

As per claim 33, all the limitations of this claim have been noted in the rejection of claim 20. It is therefore rejected as set forth above.

Remarks

Applicant states that "the present invention sets forth the use of tokens when determining if a copy of the requested reference material is available" and that "Vellandi does not disclose the use of such tokens". The Examiner respectfully disagrees and respectfully provides a reference [**Vellandi U.S. Patent 6,385,614**] that set forth the use of cookies when determining if a book is available to be shared over a network. Vellandi makes use of cookies maintained in the server as well as a book and then the server passed the cookie to a user of the network when a request is made by the user. The passing of the cookie to the user is an indication that a determination was made

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prior that a copy of the book is available in the server. In Vellandi, a cookie is part of the World Wide Web, and it is being circulated within the network to indicate the state of communication between the web server and all the users. Notice: the environment disclosed by Vellandi is the Internet and the Internet is a connection of multiple networks of computers where multiple users can have access to information; and a token is nothing, but an object that circulates among nodes of a network and describes the current state of the network. Therefore, the cookie disclosed by Vellandi is similar to the "token" claimed since they are both used for the purpose of indicating when a material is available in a network.

Applicant also argued "Vellandi uses the cookies to determine if the person requesting a document is allowed to view it, not whether the server has a copy of the document". However, the Examiner disagrees with the preceding argument because such line of argument indicates that the Applicant did not consider the Vellandi reference as a whole. Vellandi provides makes use of the cookies for more than what the Applicant is indicating. In particular, Vellandi provides "state" tracking use of the cookies as well as to terminate a user's exclusive rights (See Vellandi Col. 2, lines 1-11).

Last, Applicant argued, "the sending of a client side agent is not the same as sending a cookie". In this line of argument, the Applicant simply states what "the sending of a client side agent" is not rather, than making clear for the record what is

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meant by "the sending of a client side agent". Therefore, the Examiner respectfully submits that Vellandi disclose the claimed feature of "transmitting a client side agent form a server" as transmitting a cookie to the requested subscriber and "receiving an indication from the client side agent when the copy of the requested reference material has been replaced in a client side browser" (See Vellandi Col. 6, lines 18-58).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is 703 305-4006. The examiner can normally be reached on Monday - Friday from 10:30AM -10:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703 308 1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 3900.


Frantz Coby
Primary Examiner
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December 18, 2003